

REMARKS

In the Office Action dated May 18, 2004, claims 1, 6, 8-11, 13, 14, 29, and 37 were rejected under 35 U.S.C. § 102 over U.S. Patent No. 5,784,581 (Hannah); claims 27 and 31 were rejected under § 102 over U.S. Patent 6,453,034 (Donovan); claims 2, 18, 23-25, and 32-35 were rejected under § 103 over Donovan alone; claims 4, 16, 17, 19-22, 28 and 36 were rejected under § 103 over Donovan in view of Hannah; claims 3, 7, 30, and 41 were rejected under § 103 over Hannah in view of Donovan; and claim 12 was rejected under § 103 over Hannah in view of U.S. Patent No. 6,081,533 (Laubach).

It is respectfully submitted that the subject matter of claim 1 is not disclosed by Hannah. Claim 1 recites receiving, by a system, a message from a first device to establish a communication session with a USB peripheral device, the message being according to *a first telephony protocol defining real-time interactive sessions*. Claim 1 also recites converting, in the system, between data according to the first telephony protocol and data according to a second protocol that defines a USB peripheral link from the system to the USB peripheral device.

In Hannah, FIG. 2C shows that the VCR 20 is not a USB device. Hannah, 5:2-3. In FIG. 2C of Hannah, the protocol converter 31 converts between USB signals and a protocol utilized by the VCR 20. Hannah, 5:3-6. Although this protocol converter 31 converts between signals according to the VCR protocol and USB signals, the protocol converter 31 does not receive a message according to a first *telephony protocol defining real-time interactive sessions*. The VCR protocol is not a *telephony* protocol. Because Hannah fails to disclose a first telephony protocol, Hannah also fails to disclose converting between data according to the first *telephony* protocol and data according to a second protocol that defines a USB peripheral link, as further recited in claim 1.

In view of the foregoing, it is respectfully submitted that claim 1 is not anticipated by Hannah. Independent claim 37 is allowable over Hannah for reasons similar to those of claim 1.

It is respectfully submitted that Hannah also does not disclose the subject matter of independent claim 13. Claim 13 recites receiving another message to establish a second communication session while the first communication session is active, and performing one of sending a busy indication and over-riding the first communications session. The Office Action stated that “the system [of Hannah] inherently sends a busy indication and overriding for both calling and called telephone [sic] of a session.” 5/18/2004 Office Action at 3. Applicant

respectfully disagrees. Communication through the hub depicted in FIGS. 1-3 of Hannah relies upon the USB protocol. According to the USB protocol, a USB host controller transmits tokens and commands to attached USB hubs and USB peripheral devices. Hannah, 3:27-29. The tokens and commands issued by the host controller give permission to specific peripheral devices allowing them to transmit commands and/or data on the USB link. Hannah, 3:30-33. This token-based arbitration scheme passes a token to different peripheral devices such that *interference* between different peripheral devices do *not* occur. Therefore, there is absolutely no reason whatsoever to send a busy indication or to over-ride a first communications session, as recited in claim 13. Clearly, because Hannah teaches a completely different arbitration scheme, namely one that uses tokens passed between different peripheral devices to provide such peripheral devices the ability to communicate over a common link, it is error to say that the system of Hannah would *inherently* send a busy indication or over-ride a first communications session.

The purported invention of Hannah is that a device, such as VCR 20, can function as both a master or a slave. In its role as the master, the VCR 20 is capable of issuing tokens and commands to control operation of camera 18 such that the VCR can control the camera without the presence of an active USB host controller. Hannah, 4:57-63. The ability of the VCR 20 to function as both a USB master or slave does not change the fact that communication is still token-based, such that the sending of a busy signal and over-riding of a communications session is never *needed*.

Therefore, claim 13 is not anticipated by Hannah.

Independent claim 29 was also rejected as anticipated by Hannah. Claim 29 recites receiving a message from a telephony device, where the message is defined according to a telephony protocol. Claim 29 also recites converting the telephony protocol message into data according to a USB protocol for communication over a link to a non-telephony device. The Office Action grouped claim 29 with the rejection of claim 1. However, the Office Action provided no explanation whatsoever of how Hannah describes a system that receives a message according to a telephony protocol, or converts the telephony protocol message into data according to a USB protocol. The anticipation rejection of claim 29 is therefore defective and should be withdrawn. Moreover, it is respectfully submitted that Hannah simply does not

disclose either receiving a message according to a telephony protocol or converting between the telephony protocol message into data according to the USB protocol.

Independent claim 27 was rejected as being anticipated by Donovan.¹

Claim 27 recites converting a telephony protocol message (wherein the telephony protocol includes a Session Initiation Protocol) into data according to a first protocol for communicating over a link to a *non-telephony device*. In Donovan, a gateway 55 or 61 translates SIP signaling to different signaling, such as SS7, ISDN, or CAS signaling. The gateway 55 sends the translated signaling to a PBX 51, while the gateway 61 sends the translated signaling to a switch 33. Both the PBX 51 and the switch 33 are telephony devices. Thus, clearly, Donovan does not teach converting an SIP message into data according to a first protocol for communication over a link to a non-telephony device, as both the PBX 51 and switch 33 (as well as the telephone 53, PSTN 37, switch 39, PBX 41, and telephone 43 depicted in FIG. 2 of Donovan) are telephony devices.

In view of the foregoing, Donovan does not anticipate claim 27.

Independent claim 2 was rejected as being obvious over Donovan alone. The Office Action conceded that Donovan does not disclose a peripheral link selected from the group consisting of a USB port, a parallel port, a serial port, a SCSI port, and a PCMCIA port. However, the Office Action stated that “these ports are well known in the field of telecommunications and networks [, and it] would have been obvious to one of ordinary skill in the art at the time the invention was made to adapt the plurality of ports as recited in the claim into Donovan’s system for economic reason.” 5/18/2004 Office Action at 4.

A *prima facie* case of obviousness clearly has not been established with respect to claim 2. The Office Action has provided no objective evidence to support the allegation that a person of ordinary skill in the art would have been motivated to modify the system of Donovan to achieve the claimed invention. In fact, in the telephony network depicted in Donovan, there clearly is no reason whatsoever to incorporate a peripheral link from the identified list of ports. The only basis for the obviousness rejection is the conclusory remark made in the Office Action. No evidence was cited to provide the requisite suggestion or motivation to modify Donovan to

¹ Although the introductory sentence of paragraph 1.2 of the Office Action referred to a rejection under § 103, the discussion provided in paragraph 1.2 indicates that a § 102 rejection was intended. In fact, paragraph 1.2 is grouped

achieve the claimed invention. Without the required objective evidence, it is respectfully submitted that the rejection of claim 2 is defective.

The obviousness rejections of independent claims 18 and 32 over Donovan alone are similarly defective.

Independent claim 16 was rejected as being obvious over the asserted combination of Donovan and Hannah. To establish a *prima facie* case of obviousness, at least the following requirement must be satisfied: there must be some motivation or suggestion to combine the reference teachings. M.P.E.P. § 2143 (8th ed., Rev. 2) at 2100-129. The motivation stated by the Office Action to combine the teachings of Donovan and Hannah is “economic reason.” 5/18/2004 Office Action at 5. However, there does not appear to be any suggestion that using the USB system described in Hannah in the Donovan system would make the Donovan system more “economic.” In fact, the opposite would be true, since the gateways 55 and 61 would have to be retrofitted to accommodate USB ports and interfaces. In Donovan, the interface of each gateway 55 and 61 to the IP network 47 is an IP stack, while the interface between the gateway 55 and PBX 51, and between the gateway 61 and switch 33, are standard circuit type and switch links. There is absolutely no need whatsoever to incorporate a USB interface between the gateway 55 or 61 and the IP network 47, or to incorporate a USB interface between the gateway 55 and PBX 51 or between the gateway 61 and switch 33.

It is well established law that “[t]he mere fact that the prior art could be so modified would not have made the modification **obvious** unless the prior art suggested the **desirability** of the modification.” *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (emphasis added). As the Federal Circuit has stated, “virtually all [inventions] are combinations of old elements.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). “Most, if not all, inventions are combinations and mostly of old elements.” *Id.* “Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

with other § 102 rejections. Therefore, Applicant is treating the rejection of claim 27 (and claim 31) as being a

Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" *Id.*

Here, there is absolutely no reason to incorporate the USB system described in Hannah into the system of Donovan. The only rationale for combining the reference teachings is impermissible hindsight that benefited from the disclosure of the present invention. Absent the disclosure of the present invention, the references Donovan and Hannah provide absolutely no motivation that would suggest to combine the teachings of the references. Therefore, the obviousness rejection of claim 16 is defective.

Dependent claims are allowable over the references for reasons similar to those of corresponding independent claims.

In view of the foregoing, all claims are in condition for allowance, which action is respectfully requested.

The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0042US)

Respectfully submitted,

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